



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,189	08/02/2006	Philippe Boyer	0630-1009	6799

466 7590 09/30/2010  
YOUNG & THOMPSON  
209 Madison Street  
Suite 500  
Alexandria, VA 22314

EXAMINER
----------

FINDLEY, CHRISTOPHER G

ART UNIT	PAPER NUMBER
----------	--------------

2621

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

09/30/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,189	<b>Applicant(s)</b> BOYER ET AL.	
	<b>Examiner</b> CHRISTOPHER FINDLEY	<b>Art Unit</b> 2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-14 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 9-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/02/2006</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

3. The Applicant's Specification, as filed 8/02/2006 states, "According to the invention, it is proposed to dispose between the sensor 6 and that part of the inner face of the body arranged plumb with the zone of detection 9, a foam element 14 of so-called electrostatic type, i.e. a conductive foam whose resistivity is at least equal to 5 MΩ.cm." (Specification page 6, lines 2-5, emphasis added) Claim 13 recites the limitation that "the resistivity of the foam element (14) is less than 5 MΩ.cm." (emphasis added) This claim limitation directly conflicts with the Applicant's disclosure, as quoted above.

4. Furthermore, claim 14 recites the limitation that "the thickness of the foam element (14) before compression is of the order of 5 mm and the resistivity of that part thereof in contact with the inner face of the casing (2) is of the order of 300 kΩ.cm, the resistivity of its opposite face is of the order of 3000 kΩ.cm and the resistivity of the central part of the foam element (14) between the extreme layers is of the order of 1500

kΩ.cm.” While this limitation is supported by the Applicant’s Specification on page 7, lines 5-15, the Examiner notes that such disclosure and claim language also conflict with page 6, lines 2-5, of the Applicant’s Specification, as quoted above.

5. It is believed that page 6, lines 2-5, of the Applicant’s Specification erroneously state “at least equal to” where said lines should state “less than.” The Examiner respectfully requests the Applicant to resolve this issue. However, the Examiner also would like to caution the Applicants that changes to the Specification may possibly constitute new matter.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (US 5771067 A, hereinafter referred to as “Williams”) in view of Squilla et al. (US 7139016 B2, hereinafter referred to as “Squilla”) in view of Miki et al. (US 6867380 B2, hereinafter referred to as “Miki”).**

Re **claim 8**, Williams discloses a camera for medical, particularly dental, use, comprising an elongated casing (2) adapted to be held in a user's hand (Williams: Fig. 1) and provided at its anterior end with image-taking means (Williams: Fig. 1 and 2 with column 5, lines 43-46, the optical system and the CCD camera are disposed in the

Art Unit: 2621

distal portion of the elongated cavity of the housing), this casing (2) comprising control means (6, 8) of sensitive type (Williams: column 6, lines 44-48, external switches control a thermal printer, video processor, and recording device), these control means comprising a zone of detection (9) located on the casing (2) which is defined by a surface discontinuity such as a hollow or a crest (11) (Williams: Fig. 1: external switches 37 are shown surrounded by a ridge), characterized in that the casing (2) contains a sensor element (6) associated with an electronic piloting circuit (8) (Williams: column 6, lines 27-36, the external switches are electrically coupled to a video processor, a recording device, and a thermal printer).

Williams does not explicitly disclose that the control means is adapted to "freeze" on display means (5) an image chosen by the user. However, Squilla discloses an intra-oral camera system, wherein a video control unit interacts through a CPU and user controls to provide functionality for several modes, including a mode for stopping the imagery at any point (i.e., "freeze-frame") (Squilla: column 5, lines 16-24). Since both Williams and Squilla relate to camera systems for use in dental applications, one of ordinary skill in the art at the time of the invention would have found it obvious to combine the freeze-frame capability of Squilla with the Camera housing of Williams in order to maximize the ease of use by the dentist by providing a compact, portable system capable of real-time control.

Neither Williams nor Squilla specifically discloses an electrostatic foam element (14) of which one end is applied against the sensor element (6) and its opposite end is applied against a zone of the inner face of the casing (2) disposed plumb with the zone

Art Unit: 2621

of detection (9). However, Miki discloses an electronic apparatus, which includes push-switch clusters (Miki: Fig. 5 and column 4, lines 15-32), wherein the push-switch clusters have a center runner made of metal (Miki: column 4, lines 37-43), and the electrical potential of the center runner is fed to a touch-detecting means, which may be formed of an electrostatic sensor, so as to sense the electrostatic capacity of the center runner and output the sensed capacity to the operation controller (Miki: column 4, lines 43-47). Since the push-switches of Miki pertain to controls mounted on a camera apparatus, one of ordinary skill in the art at the time of the invention would have found it obvious to include push-switch buttons of Miki, incorporating electrostatic sensing material, on the housing of the combined system of Williams and Squilla in order to prevent unintentional operation of the camera functions, thus providing more accurate control of the camera device (Miki: column 4, lines 59-65).

***Allowable Subject Matter***

**8. Claims 9-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.**

The following is a statement of reasons for the indication of allowable subject matter: Claims 9-12 recite particular characteristics of an electrostatic foam element that are not taught or suggested by the prior art. While the prior art renders the inclusion of an electrostatic material (such as foam) obvious, as noted above in the

Art Unit: 2621

rejection for claim 1, the prior art of record fails to fairly teach or suggest the particular compression, shape, and resistivity characteristics recited in claims 9-12.

### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER FINDLEY whose telephone number is (571)270-1199. The examiner can normally be reached on Monday-Friday (8:30 AM-5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/

Application/Control Number: 10/588,189

Page 7

Art Unit: 2621

Supervisory Patent Examiner, Art Unit 2621

/Christopher Findley/